



PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number 16010-06209	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on <u>June 2, 2006</u>  Signature <u><i>Raj P. Patel</i></u>  Typed or printed name <u>Rajiv P. Patel, Reg. No. 39,327</u>	Application Number 10/006,332		Filed November 30, 2001
	First Named Inventor Christopher A. Johns		
	Art Unit 2173	Examiner Cao H. Nguyen	
<p>Applicant requests review of the rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>39,327</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p style="text-align: right;"><u><i>Raj P. Patel</i></u> Signature <u>Rajiv P. Patel</u> Typed or printed name <u>(650) 335-7607</u> Telephone number <u>June 2, 2006</u></p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
*Total of <u>1</u> form is submitted.			



**ATTACHMENT TO THE**  
**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Introduction**

This request is filed under Official Gazette (“O.G.”) Notice: “New Pre-Appeal Brief Conference Pilot Program.” Pending claims 1-40 are in the “Response to Examiner Regarding Final Office action” (“Response”) filed on February 23, 2006. Applicants’ have already received two Office actions in this application. The Pre-Appeal Brief seeks to (1) have the Examiner review each and every limitation in each claim before him and (2) allow the pending claims because the references, either alone or in combination, fail to disclose, suggest or teach each and every element of the pending claims.

**Claims Not Properly Examined**

In a final Office action dated September 8, 2005, claims 1-40 were rejected under 35 USC § 103(a) as allegedly being unpatentable in view of U.S. Patent no. 5,987,504 to Toga (“Toga”) and U.S. Patent No. 6,546,417 to Baker (“Baker”). Applicants noted a number of deficiencies in this final Office action, and discussed same with Examiner via teleconferences on October 3, 2005, December 2, 2005 and December 15, 2005. Applicants forwarded memoranda of these teleconferences via fax on October 2, 2005, December 5, 2005, and December 19, 2005. In addition, Applicants also send an email to the Examiner on December 19<sup>th</sup> confirming such discussions and requesting a revised Office action that complied with proper examination as set forth by the law.

Examiner forwarded a revised final Office action dated December 28, 2006 (“revised final action”), wherein claims 1-40 were again rejected, again, with most of the prior deficiencies uncorrected. In order to formally document these examination failures, Applicant filed the

aforementioned Response. On March 16, 2006, in reply to the Response Examiner mailed an Advisory Action asserting that “The reply filed 28 February 2006 [sic] fails to place this application in condition for allowance because: The claimed invention as represented does not distinguish over the prior art combination of Toga and Baker.”

Applicants respectfully request a pre-appeal brief conference to address clear factual and legal errors in Examiner’s rejection of pending claims 1 through 40. The deficiencies persisting in the December 28, 2005, final Office action do not fully considered Applicants’ claim amendments and other efforts to advance this case. The uncorrected deficiencies include, *inter alia*, incorrect recitation, and thus examination, of the pending claims as discussed below.

#### **Claimed Invention Not Taught By Prior Art of Record**

In the revised final action dated December 28, 2005, the Examiner rejects pending claims 1-4, 9 and 19 by only showing a subset of the recited elements as taught by the art of record. (Response, pp. 11-14). For example, in claim 1 Examiner fails to address claim amendments pertinent to the first element in addition to other elements. (*Id.*). The rejection is under 35 USC § 103, and thus, clearly has novelty. However, as further described below, it also is not obvious because Examiner has not shown how the combination teaches or suggests each and every element of the claimed invention. Hence, these claims should have been allowed by Examiner. (*Id.*). The same issues apply to claims 9 and claim 19, and therefore, these claims should be allowed. (*Id.*). Further, Examiner conflates the elements of pending claims 2-4 rather than considering each and every limitation of the presented claims. Thus, Examiner has not shown how the combination teaches or suggests the claimed invention, and therefore, these claims should be allowed. (See *Id.*; Amendment and Response filed June 16, 2005)).

### **Prima Facie Case of Obviousness Not Established**

As noted above, Examiner failed to establish a prima facie case of obviousness under 35 USC §103(a). For a prima facie case, the cited reference or references must collectively disclose or suggest every element of the rejected claim. The references cited in the revised final action do not disclose or suggest each element of independent claims 1, 10, 19 and 28. Representative claim 1 recites a method for reformatting messages for multiple display environments and recites, *inter alia*, reformatting for optimized visual presentation on a user interface, according to a visual format defined by a display parameter. (Response p. 13).

The primary cited reference, Toga, discloses facilitating information flow through a network. (Response pp. 13-14). However, Toga fails to disclose or suggest, for example, determining a visual presentation of a user interface including a message display area having a first visual format that includes a first display parameter. Toga discloses receiving a message, but fails to disclose receiving a message for display within a message display area, the message having a second visual format that differs from the first visual format. A message displayed by the system disclosed in Toga would generate a misalignment according to the first display parameter. Toga also fails to disclose automatically reformatting the message to generate a reformatted message that conforms with the first visual format to display the reformatted message within the message display area in a manner that conforms to the first display parameter. Thus, Toga does not disclose or suggest any of the elements of pending claim 1. More importantly, Examiner's failure to consider the elements emphasized above support the notion that these elements simply do not exist in Toga. (Response p. 14). Similar arguments apply to pending independent claims 10, 19 and 28.

Moreover, Baker fails to correct the deficiencies of Toga. Baker discloses an E-mail client software having a mailbox displayer that provides a list of E-mail messages. (Response pp. 14-15). However, Baker does not disclose or suggest displaying the content of messages within the user interface in a manner as is claimed. Baker merely discloses a list of messages, but not the message itself. Thus, Baker fails to disclose or suggest receiving a message for display within the user interface, the message having a second visual format that differs from the first visual format such that displaying the message unmodified would generate a misalignment according to the first display parameter. (Response p. 15).

Likewise, Baker does not disclose or suggest automatically reformatting the message to generate a reformatted message that conforms with the first visual format. (Response pp. 15-16). The claimed invention automatically reformats a message according to a user interface display parameter (e.g., a line length or a maximum number of display lines). For example, the message may be automatically reformatted such that introduction of the message into the user interface would not result in individual words splitting across different lines, or in longer lines displaying as an erratic series of full and truncated lines. In contrast, Baker merely discloses various ways to form an icon associated with an electronic message and to display the icon and message description in the electronic mail client. (Id.). Because the content of the electronic message in Baker is never automatically reformatted, Baker does not allow a user to introduce a received message into an interface or database without substantially editing the received message to make it compatible with the interface's format. Thus, Baker differs from the claimed invention.

Finally, Baker fails to disclose or suggest displaying the reformatted message within the user interface, wherein the displayed reformatted message conforms to the first display parameter. As stated, Baker merely discloses presentation of message titles or descriptions, not

presentation of the actual messages. (Response pp. 15-16). Thus, Baker does not address the deficiencies noted with respect to Toga and nor does Baker disclose any of the elements of claim 1. Similar arguments apply to amended independent claims 10, 19 and 28. Thus, for at least this and the other reasons above, claims 1, 10, 19 and 28 are patentably distinguishable over the cited references, both alone and in combination. Therefore, Applicants respectfully request that the rejection of these claims be withdrawn and the application be allowed.

### **Patentability of Dependencies**

Dependent claims 2-9, 11-18, 20-27 and 29-40 variously depend from independent claims 1, 10, 19 and 28 and derive their patentability from the independent claims from which they depend, in addition to reciting additional patentable features. For example, claims 2 and 3 recite that the first visual format further includes a second display parameter; that the displayed reformatted message conforms to the first display parameter and the second display parameter; that the first display parameter is a line length and the second display parameter is a maximum number of display lines. (Response p. 17). Claims 4-8 recite aspects of the method of automatically reformatting a message. Claim 9 recites an application comprising a network based customer service system which saves the reformatted message in a database. (Id.) Dependent claims 11-18, 20-27 and 29-40 similarly derive their patentability. (Id.) Therefore, Applicants respectfully request that the rejection of these claims also be withdrawn and the claims allowed.

### **Conclusion**

Claims 1-40 as presently before the Examiner have been shown to be allowable. Applicants request reconsideration of the basis for the rejections and allowance of these claims at this time.